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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055795
Party	Plaintiff Terrence Hastings
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Date	11/20/2013
Attachments	N1407 Opposition to Respondent's Motion for Sanctions and Exhibits A-C.pdf(1384989 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 4,122,970
For the Mark: E.F. HUTTON
Date registered: April 3, 2012

In the matter of Trademark Registration No. 4,126,754
For the Mark: EF HUTTON and Design
Date registered: April 10, 2012

_____)	
TERRENCE HASTINGS,)	Consolidated Cancellation No. 92055795
)	
Petitioner,)	
)	
v.)	
)	
E.F. HUTTON GROUP, INC.,)	
)	
Respondent.)	
_____)	

Trademark Trial and Appeal Board
Commissioner for Trademarks
PO Box 1451
Alexandria, Virginia 22313-1451

**PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION FOR
SANCTIONS AND REQUEST FOR TELEPHONE CONFERENCE**

Petitioner, Terrence Hastings, through his undersigned counsel, hereby submits
this opposition to Respondent's Motion for Sanctions filed with the Board on October
12, 2013, pursuant to 37 C.F.R. § 2.127 (e)(1).¹

¹ Petitioner attaches hereto as "Exhibit A" and "Exhibit B" his Motion to Compel the deposition of Mr. Eric Von Vorys and his Reply to Respondent's Opposition to Petitioner's Motion to Compel, and incorporates the arguments set forth therein by reference.

Preliminary Statement

Federal Rule Civil Procedure 11(d) prohibits the filing of this type of Motion for discovery matters; Petitioner's Motion to Compel was a timely discovery matter as to the merits, then should Respondent have its way, then any party who wishes to avoid testimony about its factual bases for allegations contained in a statement of use, may do so by merely having its attorney sign all Statements of Use and effectively stone-wall the opposing party from examination into the veracity of the statements contained therein.

I. Respondent's Motion for Sanctions Filed Pursuant to Rule 11(b) of the Federal Rules of Civil Procedure is Improper

Respondent argues that Petitioner, by filing a motion to compel the deposition of Mr. Von Vorys, who signed the Statements of Use in the underlying trademark applications (and who is counsel to Respondent) was in violation of Rule 11(b) of the Federal Rules of Civil Procedure. *See* Motion for Sanction at 3-7. Rule 11(d) clearly states, Rule 11 "does not apply to disclosures and discovery requests, responses, objections, and motions under Rules 26 through 37." *See* Fed. R. Civ. P. 11(d); TBMP § 527.02(d) (emphasis added). Similarly, the TTAB case law and the TBMP states, a motion for sanctions regarding discovery is applicable "only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has assertedly been violated." *International Race of Champions, Inc. v. Phillip Horne*, 2001 TTAB LEXIS 799, at *8-9 (TTAB Nov. 6, 2001) (non-precedential) (citing TBMP § 527.01; *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB

1976); *Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747 (TTAB 1975); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974)). In that instance, a party's recourse is to bring a motion for sanctions under Federal Rule 26(g). However, Respondent did not follow the required procedure of filing a protective order and instead improperly filed this Motion for Sanctions under Rule 11.

Respondent also claims that Rule 11 should somehow apply because the Petitioner's Motion to Compel the discovery deposition of Mr. Von Vorys is outside the discovery process. This argument fails for several reasons.

As previously noted, Petitioner noticed and intended to take Respondent's deposition during the discovery period, as outlined in Petitioner's Motion to Compel. *See* Motion to Compel at 5-6. Respondent's witness, Mr. Von Vorys, refused to timely appear for the scheduled deposition. Even though Respondent's witness refused to testify during the discovery period, Respondent currently asserts that Petitioner's Motion to Compel the discovery deposition is outside the discovery period and therefore Rule 11(d) is inapplicable. However, this ignores the fact that a motion to compel discovery after the discovery period has ended relates back to the "the earlier timely request." *See generally Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974); *see also Well's Dairy, Inc. v. Richard D. Bristow*, 2001 TTAB LEXIS 126, at *2 (TTAB Feb. 12, 2001) (the Board granted an unconsented motion to compel the testimony of the applicant's witness, which was filed after the close of discovery).

Federal Rule 11(d) states that Rule 11 is inapplicable to discovery. Here, the conduct described in Respondent's Motion for Sanction is in direct response to Petitioner's Motion to Compel discovery and the Federal Rules and federal case law

indicate that Rule 11 does not apply in this situation. *See* Fed. R. Civ. P. 11(d); *see also* *Guimaraes v. NORs*, 366 Fed. Appx. 51, at * 53-54 (11th Cir. Fla. 2010) (“Under Rule 11, a party may move for sanctions in some situations, but the rule explicitly states that it ‘does not apply to disclosures and discovery requests, responses, objections, and motions under Rules 26 through 37’”) (citing Fed. R. Civ. P. 11(d)); *Rates Tech., Inc. v. Mediatix Telecom, Inc.*, 2007 U.S. Dist. LEXIS 52781, at *4 (E.D.N.Y. Mar. 16, 2007) (“Additionally, Fed. R. Civ. P. 11(d) states that ‘subdivisions (a) through (c) of this rule do not apply to disclosures and discovery requests, responses, objections and motions that are subject to the provisions of Rule 26 through 37’”) (citing *Avent v. Solfaro*, 223 F.R.D. 184, 187-188 (S.D.N.Y. 2004) (“denying motion because it related to discovery disputes and thus, did not fall within the purview of Rule 11”). Therefore, Respondent’s Motion for Sanctions is improper and should be denied by the Board.

II. Petitioner’s Motion to Compel was Timely Filed

Respondent argues that the filing of a Motion to Compel after the close of discovery is not only improper but *sanctionable* under Rule 11. *See* Motion for Sanctions at 2-3. Petitioner filed its Motion to Compel pursuant to 37 C.F.R. § 2.120(e), which states, in pertinent part, that a motion to compel “must be filed prior to the commencement of the first testimony period as originally set or as reset.” Petitioner’s Motion to Compel was filed on September 30, 2013. The commencement of the first testimony period, as reset, was October 1, 2013. The Motion was therefore timely filed.

Petitioner served the deposition notice of Respondent's counsel, Mr. Von Vorys, on July 12, 2013, well prior to the close of discovery on August 2, 2013. Respondent's counsel subsequently indicated that he would not appear for his scheduled deposition and indeed failed to do so. Thereafter, pursuant to 37 C.F.R. § 2.120(e), Petitioner engaged in numerous good-faith efforts to resolve the dispute without the necessity of filing a motion to compel.

During the same time period, Petitioner sought alternative methods of securing the requested testimony by deposing Respondent's principal, Mr. Christopher Daniels on September 12, 2013. This deposition took place outside the close of discovery by stipulation of the parties due to Mr. Daniels's earlier unavailability. In the letter to Petitioner's counsel dated August 27, 2013, attached hereto as "Exhibit C," Mr. Von Vorys suggested that the sought after testimony could be obtained through the deposition of Respondent's principal, Christopher Daniels without the need to depose Mr. Von Vorys. Subsequently, when Mr. Daniels was asked for the factual basis for Respondent's counsel's signing the Statements of Use, he stated that he had no knowledge of the factual circumstances surrounding his attorney's signing of the Statements of Use, *see* Portions of Mr. Daniels' deposition testimony attached here to as "Exhibit D," thus, making the need to depose Mr. Von Vorys clear.

III. Respondent's Motion for Sanctions in Retaliatory and Frivolous

In response to Petitioner's Motion to Compel, Respondent sets forth an additional reason for filing its Motion for Sanctions:

Here, Petitioner filed a Motion to Compel the deposition of Respondent's attorney, knowing that any testimony would be protected by the attorney-client privilege.

Motion for Sanctions at 5. However, Respondent's counsel's outrage in being noticed for discovery deposition is misplaced and cannot provide an adequate basis for Respondent's Motion for Sanctions. Mr. Von Vorys knew, or should have known, the inherent risks involved in signing a Statement of Use, such as being called to testify as a fact witness. He chose to do so anyway. The attorney-client privilege does not shield factual statements made to the Trademark Office. Since this cancellation alleges fraud on the Trademark Office in the filing of Statements of Use, Petitioner's request to seek Respondent's counsel's limited deposition testimony as to the truth of these statements contained in the Statements of Use is both relevant and proper.

Respondent does not argue that it is improper or not relevant to seek the deposition of the signatory of a Statement of Use, the fundamental right to seek this type of factual discovery in a trademark cancellation proceeding is clear. Rather, Respondent argues, in a conclusory manner, that since the signer of the Statements of Use in this proceeding is Respondent's attorney, any attempt to seek the attorney's deposition must by definition be harassing, frivolous, and/or otherwise violate Rule 11. *See* Motion for Sanctions at 4 -5. Respondent's argument is flawed and unsubstantiated.

The Federal Circuit finds that a frivolous "argument or claim [a]s one that is both baseless and made without a reasonable and competent inquiry." *S. Bravo Sys., Inc. v. Containment Technologies Corp.*, 96 F.3d 1372, 1375 (Fed. Cir. 1996). Similarly, a legal position is substantially justified if there is a genuine dispute as to proper resolution or if

a reasonable person could think it correct, that is, if it has a reasonable basis in law and fact. *Decision Insights, Inc. v. Sentia Grp., Inc.*, 311 Fed. Appx. 586 (4th Cir. 2009).

Here, the issue of whether an attorney who signed a Statement of Use can be called as a relevant witness to testify as to the basis of the factual allegations contained therein appears to be a matter of first impression before this Tribunal. Respondent's counsel has admitted that he has not found any relevant precedent of the Trademark Trial and Appeal Board on the issue of whether Petitioner can take the deposition of a relevant fact witness who signed a Statement of Use when that attorney is counsel of record. *See* Motion for Sanctions at 7n3. There is, however, precedent in other Federal courts where the deposition of an attorney in a trademark litigation was deemed proper. *See Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178 (5th Cir. 1980) (a trademark attorney testified regarding generic use of the trademark); *Audi AG v. Shokan Coachworks, Inc.*, 592 F. Supp. 2d 246, 262 (N.D.N.Y. 2008) (a party's in-house counsel testified to the terms of a settlement agreement); *Kellogg Co. v. Toucan Golf, Inc.*, 2001 WL 34082276 (W.D. Mich. Sept. 6, 2001) *aff'd*, 337 F.3d 616 (6th Cir. 2003) (a party's trademark counsel testified regarding advertising materials); and *Oreck Corp. v. Thomson Consumer Electronics, Inc.*, 796 F. Supp. 1152, 1155 (S.D. Ind. 1992) (a party's trademark attorney gave depositions testimony regarding existence of negotiations for permitted use of the trademark). Petitioner's basis for seeking the deposition of the signer of the Statements of Use is sound.²

² Petitioner notes that he could have filed his own Motion for Sanctions against Respondent for filing the instant Motion; however, Petitioner strongly desires to avoid any further waste of time or resources of the parties or the Board with such frivolous motion practice.

Conclusion

Respondent filed its Motion for Sanctions knowing that it was procedurally improper and without a substantive basis. Petitioner respectfully requests that the Board deny Respondent Motion for Sanctions. Additionally, Petitioner respectfully requests a telephone conference between the Board and the parties to quickly dispose of this Motion without further delay and waste of judicial resources.

Respectfully submitted for,
Terrence Hastings

By: 

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Attorneys for Petitioner

Dated: November 20, 2013

CERTIFICATE OF SERVICE

I, Govinda M. Davis, hereby certify that on November 20, 2013, I caused a true and correct copy of the foregoing **Opposition to Respondent's Motion for Sanctions** to be filed with the Trademark Trial and Appeal Board and served via first class mail, postage pre-paid, upon the following counsel of record:

Shulman Rogers Gandal Pordy & Ecker, P.A.
12505 Park Potomac Ave Fl 6
Potomac, MD 20854-6803
Attention: Mr. Eric J. Von Vorys



EXHIBIT A

Terrence Hastings v. E.F. Hutton Group Inc.
U.S. Trademark Cancellation No. 92055795 against Registration Nos. 4122970 and 4126754
Petitioner's Exhibits to its Opposition to Respondent's Motion for Sanctions

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 4,122,970
For the Mark: E.F. HUTTON
Date registered: April 3, 2012

In the matter of Trademark Registration No. 4,126,754
For the Mark: EF HUTTON and Design
Date registered: April 10, 2012

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TERRENCE HASTINGS,)	Consolidated Cancellation No. 92055795
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Petitioner,)	
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E.F. HUTTON GROUP, INC.,)	
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Respondent.)	
_____)	

Trademark Trial and Appeal Board
Commissioner for Trademarks
PO Box 1451
Alexandra, Virginia 22313-1451

**PETITIONER'S MOTION TO COMPEL THE DISCOVERY DEPOSITION OF
ERIC J. VON VORYS**

Petitioner, Terrence Hastings, through his undersigned counsel, pursuant to 37 C.F.R. § § 2.120(e) and 2.127, seeks to compel the deposition of Eric J. Von Vorys, the individual who signed the Respondent's Statements of Use in connection with the U.S. Trademark Registrations that are the subject of this cancellation proceeding. Petitioner respectfully requests disposition of this Motion by telephone conference between the Board and counsel. Additionally, Petitioner moves the Board to suspend the proceeding

while it resolves this outstanding Motion to Compel.

Preliminary Statement

This motion presents an issue of the fundamental right to take discovery in proceedings before the Trademark Trial and Appeal Board: namely, whether the signatory/declarant of a Statement of Use filed pursuant to 37 C.F.R. § 2.88 can be deposed with regard to the truth of the factual statements contained therein. Petitioner respectfully submits that his ability to depose the declarant as an essential right afforded under the Federal Rules of Evidence and Trademark Rules of Practice -- particularly here, where Petitioner alleges fraud on the Trademark Office and/or other deliberate malfeasance in the creation and filing of the subject specimens and statements of use.

Petitioner Has Made a Good Faith Attempt to Resolve this Dispute Prior to Filing this Motion to Compel

On July 12, 2013, Petitioner noticed Von Vorys's deposition pursuant to Federal Rule of Civil Procedure 30(b)(1). Rather than file a motion to quash the discovery deposition, Mr. Von Vorys stated that he would not appear and that his role as an attorney in this case has made him immune from having to appear at the deposition. Petitioner has made a good-faith attempt to resolve this dispute prior to bring this motion pursuant to Trademark Rule 2.120(e)(1) and TBMP § 523.02. *See*, correspondence between the parties attached hereto and incorporated herein as "Exhibit A."

Background

This is an action for cancellation based upon fraud and related causes of action in the filing of Statements of Use in connection with U.S. Reg. No. 4122970 of E.F. HUTTON and 4126754 of EF HUTTON and Design. The sworn Statements of Use in the applications leading to registrations of those marks were signed by Respondent's attorney, Eric Von Vorys. The Statements of Use are annexed hereto and incorporated herein as "Exhibit B." Mr. Von Vorys is the attorney for both the original applicant, Dominant Brands, and Respondent (the current owner of the subject registrations by assignment). Dominant Brands and Respondent are controlled by Mr. Von Vorys' client, Christopher Daniels, and have has filed numerous other applications for historical brands such as TWA, Bank of Boston, Salomon Brothers, and First Boston. *See* Petition to Cancel at ¶ 7, *see also*, Deposition of Mr. Christopher Daniels pages 25-27 attached hereto and incorporated herein as "Exhibit C."

In this action, Petitioner has *inter alia*, challenged the veracity of the Specimens, and validity of the Statements of Use filed with the Trademark Office. Relevant allegations in this matter include:

- "E.F. Hutton & Company, Inc.," the entity that allegedly sponsored the advertisement contained in the specimen, was not incorporated at the time the specimen was published and the Statement of Use filed on January 18, 2012. Petition to Cancel at ¶¶ 20-21.
- The applicant, Dominant Brands LLC, was not using the subject marks on any and/or all of the related services set forth in the identification of services at the time the specimen was published and the Statements of use filed on January 18, 2012. *Id.* at ¶¶ 29-40.
- The Applicant improperly used the ® symbol in connection with the EF Hutton and Design mark that appeared in the Specimen of Use, the identical design mark that was the subject of inactive U.S. Reg. 1,581,877 of EF HUTTON and Design

owned by the original E.F. Hutton & Company, Inc. *Id.* ¶ 41.

In addition, Petitioner has discovered that backpage.com, the free internet classified in which the specimens of use were advertised, has been investigated and cited by the Association of Attorneys General as one of the leading sex trafficking websites in the United States. This fact is germane to whether the Applicant has submitted bona fide proof of use and had bona fide use of the mark at the time of the filing of the Statements of Use. *See*, TMEP 901.02.

Argument

I. Mr. Von Vorys Is A Relevant Witness to Support Petitioner's Claims of Fraud and Related Causes of Action

Statements regarding the use of a mark on applied for goods and/or services are material to the issuance of a registration. *See, Hachette Fillipacchi Presse v. Elle Belle, LLC* 85 USPQ2d 1090 (TTAB 2007). The requirements for the signing of a Statement of Use are found in 37 C.F.R. § 2.88(b), which states, in relevant part:

A complete statement of use must include:

(1) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (*see* § 2.193(e)(1)) that:

(i) The applicant believes it is the owner of the mark; and

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce on or in connection with the goods or services identified in the notice of allowance, and setting forth or incorporating by reference those goods/services identified in the notice of allowance on or in connection with which the mark is in use in commerce.

As the declarant in the Statements of Use of the subject trademark applications, Mr.

Von Vorys attested to the existence of facts necessary to establish the statutory requirements for registration. As the declarant under 37 C.F.R. § 2.20, Mr. Von Vorys had an obligation to verify that "all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true."

In a similar case where the attorney signed the Statement of Use, the Board reasoned as follows:

Even if Xel's attorney was signing the statement of use based on information and belief, he was clearly in a position to know (or to inquire) as to the truth of the statements providing reason to believe. Statements under oath are made with a degree of solemnity requiring thorough investigation prior to signature and submission to the USPTO.

See, Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc., 86 USPQ2d 1572 (TTAB 2008) (citations omitted), see *also*, Model Rule of Professional Conduct 3.3, see *also*, *In re Brainybrawn.Com, Inc.*, 2002 TTAB LEXIS 406, *15-17 (TTAB June 26, 2002) ("Consequently, if the declaration accompanying the statement of use is signed by an attorney, then it is the attorney who additionally must be the declarant and make the averments required by Trademark Rule 2.88(b)(1); plainly, an attorney may not verify statements if the attorney has no personal knowledge, which is the case herein as applicant's attorney candidly admits.")

As the declarant in the Statements of Use, Mr. Von Vorys is a relevant fact witness on the issue of the veracity of the factual, material representations made in support of the subject registrations. This is not a case where the witness's testimony is tangential to the proceeding; indeed, it is central to the Petitioner's case to support whether the subject registrations should be cancelled for fraud and/or the intentional filing of false statements

with the Trademark Office.

II. Petitioner Has No Other Means Exist To Obtain the Information Sought From Mr. Von Vorys' Testimony

Respondent's President, Christopher Daniels, testified that he did not have any knowledge as to the factual bases for Mr. Von Vorys's statements filed pursuant to 37 C.F.R. § 2.20. *See*, Deposition of Mr. Christopher Daniels pages 91-92, attached hereto and incorporated herein as "Exhibit D." This fact further substantiates the need for the oral deposition testimony of Mr. Von Vorys. While Mr. Von Vorys is not apparently a shareholder, the company's stock directory shows that he hold shares of stock for his children. *See*, Deposition of Mr. Christopher Daniels pages 141-144, attached hereto and incorporated herein as "Exhibit E."

Petitioner has attempted to proceed in the least invasive manner. Petitioner's is pursuit of this testimony from counsel is due to the fact that counsel has chosen to interject himself as a fact witness. The Notice of Deposition only seeks a limited deposition, taken by telephone, with regard to facts only known by Mr. Von Vorys.

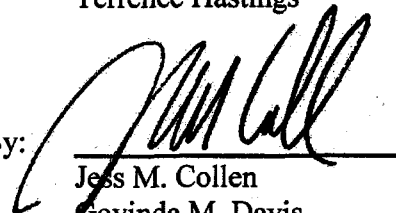
CONCLUSION

Respondent respectfully submits requests that the Board issue an order compelling Mr. Von Vorys to appear for discovery testimony as a necessary fact witness in the above-mentioned proceeding for the purpose of testifying as it relates to the circumstances surrounding his signing and filing the Statements of Use for the trademark registrations that are the subject of this proceeding. Petitioner further requests that all trial

testimony dates and subsequent dates be suspended pending disposition of this motion.

Respectfully submitted for,
Terrence Hastings

By:

A handwritten signature in black ink, appearing to read 'Jess M. Collen', written over a horizontal line.

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Attorneys for Petitioner

Dated: September 30, 2013

CERTIFICATE OF SERVICE

I, Govinda M. Davis, hereby certify that on September 30, 2013, I caused a true and correct copy of the foregoing **Motion to Compel** to be filed with the Trademark Trial and Appeal Board and served via first class mail, postage pre-paid, upon the following counsel of record:

Shulman Rogers Gandal Pordy & Ecker, P.A.
12505 Park Potomac Ave Fl 6
Potomac, MD 20854-6803
Attention: Mr. Eric J. Von Vorys

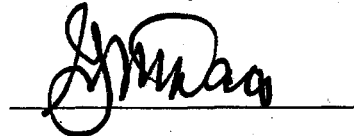
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EXHIBIT B

Terrence Hastings v. E.F. Hutton Group Inc.
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**PETITIONER'S REPLY IN SUPPORT OF HIS MOTION TO COMPEL THE
DISCOVERY DEPOSITION OF ERIC J. VON VORYS**

Petitioner, Terrence Hastings, through his undersigned counsel, pursuant to 37 C.F.R. § 2.127(a), respectfully submits this Reply in support of Petitioner's Motion to Compel the testimony of Eric J. Von Vorys.

1. The Information Sought in Mr. Von Vorys' Testimony is Relevant and Not Subject to the Attorney-Client Privilege

Respondent takes the position that seeking Mr. Von Vorys' deposition is *prima facie* improper, since everything he claims to know in connection with the requested subject matter is protected by the attorney-client privilege and rendered in connection with delivery of his legal services to the Respondent. *See* Opp. at 5. This attempt to create a shield of absolute immunity around factual statements provided to the Trademark Office, in a case that alleges fraud, lacks precedent and should not stand. Respondent incorrectly states that Petitioner has misstated the standard for fraud by citing *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 U.S.P.Q.2d 1572 (TTAB 2008). *See*, Opp. at 2-3. Petitioner cited language from *Xel Herbaceuticals* for the simple proposition that even attorneys must be truthful and accurate in their dealings with the Trademark Office. This proposition of fundamental integrity and truthfulness in dealings with this tribunal has not been overturned by *In re Bose*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), which remains the controlling authority for the standard to prove fraud in dealings before the Trademark Trial and Appeal Board.

The right to take the deposition of an attorney of record in a lawsuit is permitted where justice so requires. *See Shelton v. Amer. Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1986) (determining whether an attorney may be deposed based on the "Shelton Factors": "(1) no other means exist to obtain the information than to depose opposing counsel . . .; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the case."); *see also, Hina v. Anchor Glass Container Corp.*, 2008 U.S. Dist. LEXIS 41577 (S.D. Ohio May 23, 2008); *see*

Nicholson v. Great Lakes Towing Co., 2008 U.S. Dist. LEXIS 57559, at *6-7 (E.D. Mich. July 29, 2008) (permitting a deposition of opposing counsel that was limited in scope and relevant to the issue of legal services).

In this action, not only does the proposed witness satisfy this test, but in fact, Mr. Von Vorys, in signing the Statements of Use in this case, made statements under oath and subject to penalty of perjury. These statements were regarding Respondent's alleged use of the marks in commerce, and, included other factual representations as to the truth of the information contained in the Specimens of Use. These statements were relied upon by the Trademark Office in issuing the subject registrations. His deposition testimony is relevant, proper, and non-privileged as it relates to factual statements submitted to the Trademark Office in support of registration¹.

2. Applicant's Counsel is Properly Noticed For Testimony

For proposes of the subject cancellation action, this Board has the authority to compel Mr. Von Vorys to appear for deposition. The rationale behind the Board's requirement for a subpoena such as the limited jurisdiction over non-parties is inapplicable to the facts in this instance. While the Board does not have personal jurisdiction over non-parties, it does indeed have jurisdiction over both the parties to an action and their attorneys of record. Given the Board's jurisdiction over parties and their attorneys, the Board may order a party and/or its attorney to appear, respond, and/or command them to undertake other acts in connection with the Board's inherent powers.

¹ Petitioner notes that he also disclosed Mr. Von Vorys as a trial witness in his pre-trial disclosures served on Respondent on September 16, 2013.

This is not a case where Mr. Von Vorys is not subject to the jurisdiction of this tribunal — he is an attorney of record who has filed pleadings and motions before the Board, taken discovery, and has otherwise availed himself of the privileges and responsibilities of being a practitioner before the Trademark Trial and Appeal Board. Based on Mr. Von Vorys' relationship with Respondent, actual knowledge of the Notice of Deposition, his knowledge regarding the subject matter disputed in this cancellation, and his signing the Statements of Use that are at issue in this cancellation proceeding, he is equivalent to a party, officer, director, or managing agent and should be permitted to be deposed on notice. Most critically, counsel of record may not simply ignore a deposition notice and completely elect not to move to quash in a timely fashion. It is contrary to the Rules governing these proceedings for attorneys to simply choose to ignore a deposition notice rather than availing itself of a motion to quash.

Petitioner notes that prior to this Motion to Compel, Mr. Von Vorys did not object to appearing for his deposition based on lack of a subpoena. This resistance is only articulated for the first time in opposition to Petitioner's Motion to Compel. Prior correspondence between the parties did not indicate that Mr. Von Vorys believed that he needed to be subpoenaed in order to be deposed. Since Respondent did not originally raise this objection, the Board should not permit Respondent to raise it in response to Petitioner's Motion to Compel for the first time.

Therefore, Petitioner respectfully submits that the Motion to Compel the noticed deposition be granted in all respects, and that Mr. Von Vorys' deposition testimony as it relates to the basis of his factual representations to the Trademark Office in connection with the filing of the Statements of Use be permitted.

3. Petitioner's Motion to Compel Was Timely

Petitioner filed his Motion to Compel on September 30, 2013. Petitioner's testimony period was set to open on October 1, 2013. "A motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset." TMBP § 523.03 (citing 37 C.F.R. § 2.120(e); *see also*, *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974) (a "motion for an order to compel . . . is not untimely simply because it is made after the discovery period has expired, merely because it relates back to the earlier timely request.") Therefore, Petitioner's Motion to Compel was timely under the Trademark Rules. Additionally, Respondent acted reasonably under the circumstances by moving to compel shortly after the deposition of Mr. Daniels, when it became apparent from Mr. Daniels' testimony that he did not have knowledge of the facts regarding the declarations in the Statements of Use. *See* Petitioner's Motion at 6.

Furthermore, Mr. Von Vorys' deposition was noticed on July 12, 2013, while the discovery period closed on August 2, 2013. Petitioner's deposition notice was served and the deposition was scheduled within the discovery period. Mr. Von Vorys refused to appear for the noticed deposition during the discovery period. Additionally, while the discovery period was open, Petitioner's counsel corresponded with Mr. Von Vorys regarding Petitioner's intention to take his deposition during the period and agreed to take the deposition through other means or at a later date, if he preferred. Thus, Mr. Von Vorys was aware of the deposition notice and he should not be permitted to complain that Petitioner is now precluded from filing a motion to compel after the discovery period has

closed, when Petitioner's Motion to Compel relates back to the earlier timely deposition notice.

4. Respondent Has Waived Any Objections To Notice Of Deposition Since It Did Not File A Motion To Quash or a Motion for a Protective Order

The TBMP states that if a party objects to a notice of deposition, that party should move for a protective order or to quash the deposition. *See*, TBMP §§ 521 and 526. "A motion to quash a notice of deposition should be filed promptly after the grounds therefore become known to the moving party." *See*, TBMP § 521. Respondent neither filed a motion for a protective order in response to Petitioner's deposition notice nor as a response to Petitioner's Motion to Compel. Similarly, Petitioner did not file a motion to quash after the grounds for its objection became known, or request a Board conference to resolve the discovery dispute. The correspondence between the parties attached to Petitioner's Motion to Compel as Exhibit A demonstrates that Mr. Von Vorys knew of the Notice of Deposition and chose not request the Board's assistance if he believed that the Notice was improper. Therefore, Respondent has waived such objections.

CONCLUSION

Because the information sought from Mr. Von Vorys' testimony is non-privileged, relevant and necessary to this proceeding, Petitioner respectfully requests that the Board grant his Motion to Compel the discovery deposition of Mr. Eric Von Vorys.

Respectfully submitted for,
Terrence Hastings

By: 

Jess M. Collen

Govinda M. Davis

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Attorneys for Petitioner

Dated: October 24, 2013

CERTIFICATE OF SERVICE

I, Govinda M. Davis, hereby certify that on October 24, 2013, I caused a true and correct copy of the foregoing **Reply In Support of Petitioner's Motion to Compel** to be filed with the Trademark Trial and Appeal Board and served via first class mail, postage pre-paid, upon the following counsel of record:

Shulman Rogers Gandal Pordy & Ecker, P.A.
12505 Park Potomac Ave Fl 6
Potomac, MD 20854-6803
Attention: Mr. Eric J. Von Vorys

A handwritten signature in black ink, appearing to read "Govinda M. Davis", is written over a horizontal line.

EXHIBIT C

Terrence Hastings v. E.F. Hutton Group Inc.
U.S. Trademark Cancellation No. 92055795 against Registration Nos. 4122970 and 4126754
Petitioner's Exhibits to its Opposition to Respondent's Motion for Sanctions

August 27, 2013

VIA FIRST CLASS MAIL AND EMAIL

Jess M. Collen, Esquire
Collen IP, Intellectual Property Law P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, NY 10562

**UNDER RULE 408 FRE
WITHOUT PREJUDICE**

Re: Hastings v. E.F. Hutton Group, Inc. Cancellation No. 92/055795
Our File No.: 109039.006

Dear Jess:

This is in response to your letter dated August 23, 2013. With respect to the full complete answers to Petitioner's First Set of Admissions, we provided them on January 18, 2012. I have enclosed another copy for your review. If you have specific questions respecting these answers, please identify them and we will respond. With respect to Petitioner's Second Set of Interrogatories, I am in the process of finalizing my client's responses. I will endeavor to send them to you by your requested August 28th date.

In addition, you argue that you are entitled to take my deposition. I repeat. You are not. You assert that trademark statutes and case law clearly state that, a person, even an attorney, who signs a declaration in a Statement of Use swears under penalty of perjury that the statements contained in the declaration are true to the person's knowledge and are true upon information and belief. In support you cite *In re Brainybrawn.com, Inc.* Based on this case, you state that the verified statements require personal knowledge of the facts, which is discoverable, so you are entitled to take my deposition. With due respect, your cited case (i) is inapposite because it involved whether the attorney could physically sign the declaration for the applicant's president, (ii) does not stand for the proposition that verified statements require personal knowledge of the facts and (iii) says nothing about an attorney being required to sit for a deposition. Moreover, the case is not published precedent. Finally, published case law clearly states that attorneys are not subject to depositions when the non-privileged information sought can be discovered directly from a party.

First, *In re Brainybrawn.com, Inc.* does not hold that a party is entitled to take the deposition of a non-party attorney. Evidently, you took one sentence from dicta out of context to support your argument. The issue decided in *In re Brainybrawn.com, Inc.* concerned an attorney who signed a declaration where the declarant was the company's president. The holding in *In re Brainybrawn.com, Inc.* is that the submitted declaration was unacceptable because it was not signed by the declarant, but by the declarant's attorney for him. There is nothing in that case that holds that an attorney is required to sit for a deposition. In fact, neither "deposition" nor "testimony" appears in your cited case. As such, the case provides no support what-so-ever for your argument.

WITHOUT PREJUDICE

Trademark Rule 2.33(a) sets forth the three types of people who are authorized to sign a declaration in a Statement of Use on behalf of the applicant: "(1) a person with legal authority to bind the applicant; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney . . . who has an actual or implied written or verbal power of attorney from the applicant." As the Statements of Use for Registration No. 4122970 and 4126754 evidence, I signed the Declaration for applicant Dominant Brands LLC as its Attorney of Record under Trademark Rule 2.33(a) (3). I did not sign the declaration under Trademark Rule 2.33(a) (2) as a person with firsthand knowledge of the facts.

Second, *In re Brainybrawn.com, Inc.* is unpublished and designated as "not citable as precedent of the TTAB." As unambiguously stated in TBMP § 101.03 "Decisions that are designated by the Board 'citable as precedent,' 'precedent of the Board,' or 'for publication in full' are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form, are not binding on the Board." *Id.* Consequently, even if *In re Brainybrawn.com, Inc.* did support your argument, which it does not, it is not binding on the TTAB.

Courts have consistently held that taking the deposition of an attorney "provides a unique opportunity for harassment [because] it disrupts the opposing attorney's preparation for trial." *See e.g., Marco Island Partners v. Oak Develop. Corp.*, 117 F.R.D. 418, 420 (N.D.Ill. 1987). As a result, "courts historically have looked with disfavor on attempts to [de]pose opposing counsel." *Id.* The TTAB has followed the three part test enumerated in *Shelton v. American Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir.1986) to determine when it is proper to depose opposing counsel: the party seeking to take the deposition must prove that (1) no other means exist to obtain the information than to depose opposing counsel, (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the case." *Id.* *See also Donut Shops Mgmt. Corp. v. Mace*, 195 U.S.P.Q. 543, 545 (E.D.Va. 1977) (attorney does not have to sit for deposition because his mental impressions, conclusions, opinions or legal theories are protected against disclosure).

Here, there are other means to obtain the information you seek instead of deposing me. You are taking Mr. Daniels' 30(b) (6) deposition in approximately three weeks. You certainly can discover all of the relevant information directly from him, particularly with regard to the first use of the marks in question or the alleged intent to commit fraud on the USPTO, or any other material facts required to prove your allegations. I am not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b) (6) or 31(a) (4) to testify on behalf of a party. As such, I am not willing to appear voluntarily at your deposition, even if you arrange it to be held telephonically. I have no unprivileged information that is discoverable.

Finally, this will suffice as informal notice that if you seek a subpoena for my deposition basing it on *In re Brainybrawn.com, Inc.*, we will prepare and seek Rule 11 sanctions because your legal contentions are unwarranted by existing law and clearly designed to harass, cause unnecessary delay, or needlessly increase the cost of litigation.

SHULMAN
ROGERS

GANDAL
PORDY
ECKER

Jess M. Collen, Esquire

August 27, 2013

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WITHOUT PREJUDICE

Again, I request that you withdraw your notice for taking my deposition or I will file a motion to quash and seek sanctions. I hope that this will not be necessary.

Sincerely,

SHULMAN, ROGERS, GANDAL,
PORDY & ECKER, P.A.

By:


Eric J. von Vorys

EJV:dd

cc: E.F. Hutton Group, Inc.
Michael J. Lichtenstein, Esq.